

REMARKS

Claims 1-18, 20, 21, 23-36 and 39-78 are pending in this application.

Claims 1-18, 20, 21, 23-36 and 39-41 have been allowed.

Claims 42-78 stand rejected.

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. §102:

Claims 42-78 have been rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 4,484,027 to Lee et al.

Claims 42-78 are apparatus counterparts to allowed method claims 1-18, 20, 21, 23-36 and 39-41. Of those, claims 42, 61, 64, 76 and 77 are drafted in independent form.

Claims 42, 61, 76 and 77 are directed to an apparatus comprising a service provider configured to perform the novel method of allowed method claims 1, 21, 39 and 40, respectively. Claim 64 is directed to an apparatus comprising a client configured to perform the novel method of allowed claim 25.

It is undisputed that apparatus claims 42-78 contain functional limitations that distinguish over Lee et al. (“Lee”). Nevertheless, the Office Action ignored those limitations on allegedly proper grounds that “claims directed to an apparatus must distinguish from the prior art in terms of structure rather than function, i.e., apparatus claims cover what a device is, not what it does (MPEP §2114)”. (Office Action, ¶2) Thus, the Office Action interpreted the apparatus claims as merely “a piece of hardware” and rejected them in view of Lee’s SSTV transmitter for providing satellite television service and Lee’s SSTV subscriber receiver for receiving satellite television service.

Applicants respectfully submit that the Office Action improperly ignored the novel functional limitations of apparatus claims 42-78 in rejecting those claims as being anticipated by Lee.

First, in placing its reliance solely on MPEP §2114, the Office Action ignored the examination directives of other sections of the MPEP, including MPEP §2131, which provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single reference” (citing Verdegaal Bros v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)), and MPEP §2141.03, which provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art” (citing In re Wilson, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Thus, the MPEP requires that all claim elements be considered.

Second, the Office Action’s reliance on MPEP §2114 is misplaced. This is because the most recent case law cited in MPEP §2114 -- including In re Schreiber, 128 F.3d 1473 (Fed. Cir. 1997), In re Swinehart, 439 F.2d 210 (C.C.P.A. 1971) and Hewlett-Packard Co. v. Bausch & Lomb, Inc., 909 F.2d 1464 (Fed. Cir. 1990) -- does not stand for the proposition that “claims directed to an apparatus must distinguish from the prior art in terms of structure rather than function”, as MPEP §2114 purports it does.¹

For example, in In re Schreiber, the Federal Circuit held that an applicant can distinguish apparatus claims from the prior art based on functional limitations that are not inherently possessed by the prior art. That case addressed whether a claim for a popcorn

¹ Although In re Danly, 263 F.2d 844, the 1959 decision of the Court of Customs and Patent Appeals (C.C.P.A.), ignored a functional limitation to uphold an obviousness finding by the U.S. Patent Board of Appeals, subsequent decisions by that court (e.g., In re Swinehart) and its successor court --namely, the Court of Appeals for the Federal Circuit (e.g., In re Schreiber), have held that applicants can distinguish apparatus claims based on functional limitations that are present in such claims.

dispensing top was anticipated by a prior art oil-can dispensing unit with the same structure. 128 F.3d at 1473-78. The fact that the prior art disclosed all of the structural limitations of the claimed dispensing top was merely the beginning of the analysis. Id. at 1477 (“There is no dispute that the structural limitations recited in Schreiber’s application are all found in the Harz reference upon which the examiner and the Board relied.”). The Federal Circuit held that prior art which anticipated structure merely established “a *prima facie* case of anticipation.” Id. at 1478. Nevertheless, an apparatus claim could be distinguished from prior art with the same structure if “the prior art structure did not inherently possess the functionally defined limitations of...[the] claimed apparatus.” Id. (holding that the burden shifted to the Applicant “to show that Hartz inherently lacks the **functionally defined limitations** recited in claim 1 of the application”) (emphasis added); see also *In re Swinehart*, 58 C.C.P.A. 1027, 1030-31 (C.C.P.A. 1970) (holding that claims can be distinguished by functional limitations if the limitations are not “inherently possessed by things in the prior art”).²

Moreover, if it indeed were proper not to give any patentable weight to functional limitations when assessing the patentability of apparatus claims, then claims directed to a special purpose computer or a computer readable medium properly could be rejected over a prior art general purpose computer (e.g., a PC) or computer readable medium (e.g., a CD-ROM), respectively. That, however, is not the law. See *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir.

² MPEP § 2114 also provides, in part, that “[a]pparatus claims cover what a device *is*, not what a device *doesHewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 [sic: 1468] (Fed. Cir. 1990) (emphasis in original)). However, *Hewlett-Packard* does not stand for the proposition that “claims directed to an apparatus must distinguish from the prior art in terms of structure rather than function”. Instead, in *Hewlett-Packard*, the issue was whether an element for a “rough surface . . . [that] has a random pattern, size, and height of rough spots” for a “drive wheel,” need to have “operational differences” from prior art devices. *Hewlett-Packard*, 909 F.2d at 1468. The accused infringer, *Hewlett-Packard*, argued that this limitation did not show operational differences from prior art wheels and thus was obvious in light of them. Id. However, the Federal Circuit held that the above-quoted limitation described a different wheel and therefore the claims did not also need to show operational differences to be distinguishable. Id. (“[a]n invention need not operate differently than the prior art to be patentable, but need only *be different*”) (emphasis in original). Therefore the claimed apparatus was not obvious in light of the prior art because the rough surface of the claimed device created a different device, not an obvious modification of the prior art, regardless of mechanical operation. Id.

1994) (holding that programming a general purpose computer creates a new machine) and In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995) (holding that a tangible medium containing a computer program is patentable subject matter under 35 U.S.C. §101). See also the U.S Patent and Trademark Office's "Examination Guidelines for Computer-Related Inventions", 61 Fed. Reg. 7478, 4782, 7487 (Feb. 28, 1996) (effective March 29, 1996) (providing that "[i]f a product claim encompasses any and every computer implementation of a process ... it should be examined on the basis of the underlying process" and further providing that when examining an apparatus under 35 U.S.C. §§102 & 103 for anticipation and obviousness "[f]unctional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability.") Here, Applicants are not claiming a general purpose "piece of hardware", as asserted in ¶2 of the Office Action, but instead are claiming a special purpose service provider and client configured to implement an underlying process that has already been found to be patentably distinguishable from Lee.

Accordingly, Applicants respectfully submit that the Office Action improperly ignored the novel functional limitations of apparatus claims 42-78 in rejecting those claims over Lee. Like the surface of the "drive wheel" in Hewlett Packard (discussed in footnote 2, supra.) the "service provider" and "client" of apparatus claims 42-78, by the very nature of the novel functional limitations recited therein, are configured to be patentably different devices than the transmitter and receiver of Lee.

For at least the foregoing reasons, Applicants respectfully submit that apparatus claims 42-78 are not anticipated by Lee.

Reconsideration of the above-identified application in view of the foregoing amendments and remarks is respectfully requested.

CONCLUSION

Applicants respectfully submit that this Application is in condition for allowance for which action is earnestly solicited.

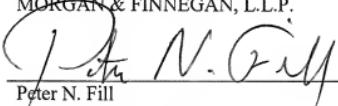
If a telephone conference would facilitate prosecution of this Application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4027. A DUPLICATE COPY OF THIS SHEET IS ENCLOSED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4027. A DUPLICATE COPY OF THIS SHEET IS ENCLOSED.

Dated: August 4, 2008

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